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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/840,145
Filing Date: May 06, 2004
Appellant(s): LASEE, JACK C.

Keith M. Baxter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 July 2009 appealing from the Office action mailed 23 January 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,259,818	STARK	4-1981
5,207,044	LASEE	5-1993
1,157,900	PLYM	10-1915
4,550,542	LASEE	11-1985
5,987,826	PETTA	11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1, 7 and 9 are rejected under 35 U.S.C. 103 as being unpatentable over Stark (U.S. Patent No. 4,259,818) in view of La See (U.S. Patent No. 4,550,542).

Claim 1: Stark discloses a window panel comprising first and second flange units (Fig. 5: 22a, 20a, respectively) each comprising a preassembled rectangular frame (Fig. 1, generally), sash elements (32a, 28a, "C" and "D" from attached Fig. 5 below respectively) that extend into the opening to capture a transparent pane (42a), at least one retention member (52a) attached to the first flange unit and extending into the opening, the member is beyond a position of the pane with respect to the first flange unit when positioned between the sash elements (it is beyond a position of the pane in the direction between the pane and the frame opening 62a) to grip a sill surface (64a) to retain the first flange unit (22a) and the sash element in position for assembly, the retention member has an end (see "A" from attached Fig. 6 from Stark, below) unobstructed by the first flange unit when the unit is in position for assembly, and at least one fastener (15a) adapted to draw the first and second flanges and the sash elements together against the pane, the sash elements include flanges extending generally parallel ("C" and "D") to the pane when captured therebetween, the ends of the flanges can flex inwardly spring biased sharp edge portions (see "B" from attached Fig. 5 from Stark, below, and the edge portions are spring-biased via fastener, 15), and the elements include flanges (20a) extending

generally parallel to the pane are spring biased via fastener (15a) in contact with the pane and the edge portion would embed in the pane when the pane is in a semi-molten state. The language "wherein said sharp edge…semi-molten in fire" lines 13 and 14 are steps that relate to a desired result and the examiner contends that as a glass pane becomes molten, it will inherently soften which would result in virtually anything imbedding in the pane if a force (such as a spring bias against the sharp edge) were applied to it. Regarding the limitation "preassembled", the limitations are drawn to method steps and only the final product, the apparatus, is provided patentable weight. The embodiment of Figure 5 from Stark does not disclose a spike as claimed, but the embodiment in Fig. 6 discloses a spike portion (65, 66) that affixes the first end to a core material of a sill surface (as shown), and the spike can be driven into the core material by impact of a hammer if desired. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the member in Fig. 6 with the member in Fig. 5 as a matter of functional equivalence that would perform equally as well.

In addition, while Stark discloses frame units that are connected, it does not disclose the units are connected by welds. La See discloses a window unit for a door with frame

members connected by welds (48: col. 4, lines 60-68). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use welds to connect the frame members because welds among frame members are well known in the art for connections and would be well within the level of skill in the art with the frame in Stark.

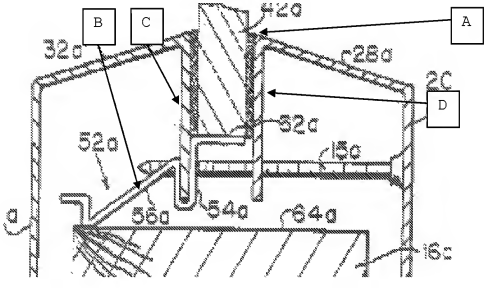

Figure 5 from Stark

Claim 7: the opening is rectangular (Fig. 1) having four sill surfaces and the vision panel has four retention members (see Fig. 4, generally), attached indirectly to the first flange unit and extending into the opening to grip all four sill surfaces.

Claim 9: a surface of the retention member (62a) supports edges of the pane.

Claims 1 and 3-6 are rejected under 35 U.S.C. 103 as being obvious over Plym (U.S. Patent No. 1,157,900) in view of La See (U.S. Patent No. 4,550,542) and Petta (U.S. Patent No. 5,987,826).

Claim 1: Plym discloses a vision panel for assembly in an opening (as shown) a first and second flange unit (see "Q" and "R" from attached Fig. 4 from Plym below) sash elements ("S" and "T" below) that extend into the opening from the flange units to capture the pane, a retention member (4) attached to the first flange unit that extends beyond a position of the transparent pane with respect to the first flange unit when positioned between the sash elements, the retention member has an end (proximate 4) unobstructed by the first flange unit when the first flange unit is in position for assembly, a spike ("U" below) positioned on the first end to affix the first end to a core material (1) a fastener (7) adapted to draw the flange units and sash elements together against the pane (10) and the sash elements include flanges (proximate actual portion 18) extending generally parallel to the pane, the ends are flexible and provide spring-biased sharp edge portions (e.g. corner

portion proximate 18 is a sharp edge) in contact with the pane and the portion would embed in the pane if the pane became semi-molten in a fire.

While Plym discloses a spike ("U") it does not disclose the spike is positioned to be driven by an impact of a hammer, as it is a screw. Petta discloses that it is known in the art to attach frame members to an opening using nails (Col. 5, lines 37-45). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a nail in place of the screw, as the two are functionally equivalent and would perform equally as well.

Further, while it is well known in the art that frame members are typically rectangular, Plym does not disclose that the members are attached via a weld. La See ('542) discloses a window unit for a door with frame members connected by welds (48: col. 4, lines 60-68). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use welds to connect the frame members because welds among frame members are well known in the art for connections and would be well within the level of skill in the art with the frame in Plym.

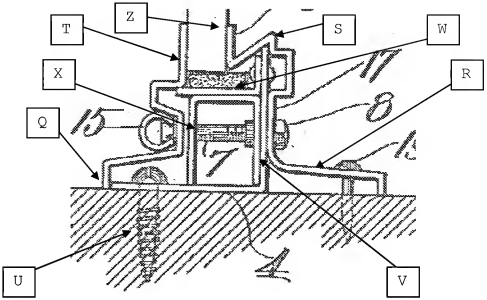

Figure 4 from Plym

Claim 3: the fastener (7) is a threaded fastener, and the second flange unit includes a hole (as shown) for receiving the threaded fastener and the retention member includes a socket (8) that can receive an end of the threaded fastener as it passed through the hole.

Claim 4: the socket is attached to the retention member by a spring element (it is indirectly attached via member "V" above) allowing movement of the socket toward the second flange unit against a spring force bias.

Claim 5: the spring element is a cantilevered tab (as shown) extending across an axis of the threaded fastener to flex with increased engagement of the threaded fastener.

Claim 6: the fastener has a non-threaded section (as shown) which would limit an engagement of the threaded fastener with the socket.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stark in view of La See and Petta (U.S. Patent No. 5,987,826).

Claim 2: Stark discloses the claimed invention including a fastening member (Fig. 6: 66) to attach the retention member to the sill, however Stark does not disclose a nail (which would result in a hole in the retention member) as a fastening means. Petta discloses a retaining member (Fig. 7: 92) with a nail (94) holding it in place. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a nail in combination with the fastening member in Stark (which would result in a hole in the retention member) because a nail is functionally equivalent to the fastening member in Stark and would perform equally as well.

Claims 11, 14 and 17-20 are rejected under 35 U.S.C. 103 as being unpatentable over Plym.

Claim 11: Plym discloses a vision panel comprising first and second flange units ("R", "Q" above respectively) sized to

frame the opening, sash elements ("S", "T") that extend into the opening and hold a transparent pane therebetween, a spring member (4) attached to the first flange and extending into the opening to support a socket ("X") on a cantilevered tab (as shown), a fastener (7) engages the second flange unit and the socket to draw the first and second flange units and sash elements together against the pane, the fastener includes a head and shank (as shown) and the shank includes a non-threaded section (as shown) between the head and threaded section, the non-threaded section limits a depth of engagement, and a portion of the socket is drawn over a non-threaded section to disengage with the fastener as the threaded fastener is advanced, and the limited depth of engagement provides a predetermined compressive force. While Plym discloses a system with a socket, it does not disclose that the socket is threaded. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the socket threaded to facilitate the connection of the threaded portion of the bolt with the framing member. Further, it would be obvious to one of ordinary skill in the art at the time the invention was made to thread the member because this is the use of a known technique to improve similar devices in the same way (citing MPEP 2141(III)).

Claim 14: the cantilevered tab is attached to the first flange, the tab extends across an axis following a length of the threaded fastener, and it would flex with increased engagement of the threaded fastener.

Claim 17: the prior art of record discloses the claimed invention including retention members (equivalent to portion "9" from Fig. 1), but it does not disclose the number of retention members used. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of duplication of parts to have this limitation because duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669 (CCPA 1960). See MPEP §2144.04.

Claim 18: the prior art of record discloses the claimed invention except for the number of holes. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of duplication of parts to have this limitation because duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669 (CCPA 1960). See MPEP §2144.04.

Claim 19: the sash elements include inwardly biased sharp edge portions (see "Z" above as the corner portion is inwardly

biased; the forces created by the frame and threaded bolt, as the members are drawn together, results in the members that are inwardly biased; in other words if the pane were not present, the members would be drawn closer to each other, which makes them inwardly biased to each other) in contact with the panel and the edge portions will embed in the panel when the panel becomes semi-molten.

Claim 20: as shown, an upper surface of the retention ("W" above) member supports the bottom of the transparent panel (as shown).

(10) Response to Argument

Rejection of Claim 1 under 35 USC §112 second paragraph:

The issue is whether the rejection of claim 1 was proper under 35 USC §112, second paragraph for the indefiniteness of "flange units" and "flanges". The focus for compliance with the requirement for definiteness of 35 U.S.C. §112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision… (citing MPEP §2173.02). The examiner maintains that the limitations are indefinite because the use of the terms, which are very similar, is unclear. One of ordinary skill in the art could easily construe "flange units" and "flanges" as the same, or different, limitation based on the

claim language and the disclosure. The examiner maintains the rejection was proper.

Rejection of claims 1, 7 and 9 under 35 USC §103(a) over Stark in view of LaSee:

The issue is whether the rejection citing the combination of Stark in view of LaSee is proper. Applicant argues that Stark does not disclose two of the limitations of claim 1. The examiner disagrees.

First, applicant states that Stark does not disclose "the retention member extend[s] beyond the window pane with respect to the first flange unit," (brief: page 11). The examiner respectfully disagrees and refers to Figure 5 of Stark. As provided in the rejection above, the examiner labeled the retention member and first flange unit as 54a and 22a respectively as provided in Figure 5 of Stark. The pane is 42a. As shown in Figure 5 of Stark, the limitation is met, as the claim does not provide which direction the retention member is to extend, as long as it is "beyond the window pane with respect to the first flange unit." Applicant additionally argues that member 52a actually extends toward member 22a. While this may be true, it extends away from the member in the same manner that

it extends toward member 22a. As a result, the limitation is met.

Second, the applicant states that that the retention member is completely enclosed by portion 22a, and that the limitation is not met (brief: page 12). The examiner included portion "A" of attached figure 5 from Stark above as a part the retention member as applicant has not provided limitations to define the retention member, and "A" above can qualify as a part of the retention member. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim…." (*Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1968 (Fed. Cir. 2004). By applying this rationale, portion "A" is unobstructed by member 22a and the limitation is met.

Rejection of claims 1 and 3-6 under 35 USC §103(a) over Plym in view of LaSee and Petta:

Applicant argues that claim 1 requires that the first and second flange units "abut a front and rear face of the door,"

(brief: page 24). The examiner respectfully disagrees. Claim 1, lines 3 and following states, "[a first and second flange unit]...sized to frame the opening and abut a front and rear face of the door". This language does not positively claim the door, but rather provides a functional limitation with respect to how the claimed invention functions with a door. The claimed language is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The prior art clearly has the functional capability to be placed in a door.

Additionally, applicant's argument that the prior art does not meet the limitation that "the retention member is attached to the first flange unit in order to retain the first flange unit and its sash element in position for assembly" (brief: page 15) is not persuasive in that this limitation is considered functional language. As claimed the prior art references are fully capable of meeting the limitations in that the retention member (Plym: 4) is attached to the first flange unit ("Q" from the attached Figure in Plym above) and retains the flange unit and sash ("S" above) in position for assembly. As shown in

Figure 4, this limitation is clearly met and the examiner maintains the rejection as proper.

Rejection of claims 11, 14 and 17-20 under 35 USC §103(a) over Plym:

Applicant's argument with respect to the Plym reference with respect to the flange unit that "abut[s] a front and rear face of the door" (brief: page 17) is not persuasive for the reasons set forth above and will not be repeated here for brevity.

Applicant's argument with respect to claim 11, that the threaded fastener does not engage the threaded socket (brief: page 17), is respectfully not persuasive. The examiner agrees that the hole in the angle plate is not threaded, but the examiner concluded that it would be obvious to make the hole threaded as stated in the rejection above. The examiner refers to Figure 4 of Plym. Tightening the bolt member (7) would, indeed, draw the first and second flange units in Plym (labeled as "R" and "Q" respectively in attached Figure 4 from Plym above) and sash elements ("S" and "T", above) together. The examiner maintains the rejection is proper.

Applicant's argument that one of ordinary skill in the art would not modify Plym to have member (4) have a threaded hole is

not persuasive (brief: page 18). While Plym does teach a nut and bolt type assembly, the examiner maintains that it is well known in the art to thread apertures such as the one in Plym for attachment purposes. Plym does not teach away from this, as applicant states, but rather is silent on the matter. Further, the examiner argues that this is the use of a known technique to improve similar devices in the same way as provided in MPEP 2141(III) in light of *KSR v. Teleflex Inc.*, 550 USPQ2d 1385 (CCPA 2007). It is known in the art to thread sockets to further facilitate attachment with threaded fasteners. The examiner maintains that having the aperture threaded would aid in facilitating the connection of the frame members.

Drawing Objection:

The examiner maintains the drawing objection as proper (brief: page 19). Applicant argues that the "flanges" are element 28, but the specification indicates members (28) in the specification as "finger portions". The specification references the "flanges" as (24) (see paragraph [0035], line 2 of applicant's specification.) As shown in applicant's Figure 3, element (24) is not parallel to the pane (32). Applicant states that the nomenclature is not relevant, however, the examiner maintains that one of ordinary skill in the art would

not see element (28) as a "flange" because it is already labeled as a "finger portion" and element (24) is labeled as a flange. The examiner respectfully maintains the objection as proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William V Gilbert/

Examiner, Art Unit 3635

/Richard E. Chilcot, Jr./

Supervisory Patent Examiner, Art Unit 3635

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